

## REMARKS

The indication of allowable subject matter in claims 1-9 and 11-17 in the Office action of October 1, 2009, is gratefully acknowledged.

Claim 1 has been amended to delete a phrase added early in the prosecution, which is not necessary to distinguish claims 1-9 and 11-17 over the applied references.

In addition, it is noted that an Interview was held on October 13, 2009, in which claim 29 was also indicated as allowable as depending from claim 11, and such indication is also gratefully acknowledged, as well as the courtesies extended by the Examiner during the Interview.

Claim 10 and 22 are presently withdrawn, however, upon the other claims being indicated as allowable herein, rejoinder is requested below.

In the Office action of October 1, 2009, a new ground of rejection was entered on claims 18-21 and 23-28 were rejected over Jones et al., U.S. Pat. No. 6,318,537 (hereafter "Jones et al. '537") in view of Geib et al. U.S. Pat. No. 5,997,395, further in view of Harris (US 5,067,928) and further in view of Carter, U.S. Pat. Pub. No. US2002/0152141.

I. RECONSIDERATION OF CLAIMS 18, 23, 24, 26 AND 28 IS REQUESTED.

Applicants have made an amendment to claims 18, 23, 24 and 26, not in view of Geib et al., but to further distinguish Carter, U.S. Pat. Pub. No. US2002/0152141, and the purported combination of Carter with Jones et al. and Harris. and reconsideration of these claims is respectfully requested.

Carter, U.S. Pat. Pub. No. 2002/0152141 discloses a computer program (Abstract, first sentence) that reconciles or balances revenue

contained in cash drawers at the ends of cashier's shifts separate from the physical storage and handling of coins.

Carter discloses that a program runs on a computer 12 (para. 0031) under the direction of an operator (not a cashier-employee) (paras. 0066-0068, for example.) and produces a reconciliation report (Para. 0072.) The computer 12 is connected to external hardware including an external sorter/counter 15 and a scale 14. (Fig. 1, para. 0023.)

Carter's coinage is held in an inventory of loose change 200 (para. 0055), separately from the computer 12 and the sorter 15 and only generally described in paragraph 0055. Carter only discloses a tedious method for manually handling coins using a scale 14, for handling and weighing coins repeatedly as they are placed in the cash drawers in paras. 0061-0065. These are manual coin handling processes. There is no detailed discussion of how the sorter 15 is used, but the coins would have to manually loaded and transferred from the sorter to the cash drawer, and coins received at the sorter would be emptied out and placed in the inventory of loose change.

Accompanying this reply is an Information Disclosure Statement including citation to subsequent Carter Patents, including U.S. Pats. No. 6,896,177 and No. 7,073,707 resulting from U.S. Pat. Pub. No. US2002/0152141. It can be seen from a review of the claims therein, that Carter uses the weighing scale and manual transfers of coinage in U.S. Pat. No. 6,896,177, claim 1 steps (a), (b) and (c) and manual transfers of coinage in U.S. Pat. No. 7,073,707, claim 1 step (a) and claim 10, steps (a) and (b).

Settlement accounting in computers has been known both before Carter as shown by the references in its file history and after Carter. There are known cash settlement software packages for running on a separate computer, but this requires essentially manual handling of the coins and manual entering and re-entering of coinage totals, a tedious and time consuming affair.

Therefore, to clarify that the accounting functions are interfaced to the sorter, the bulk coin storage receptacles and the dispensing hoppers for automatic operation, and not manual operation as disclosed in Carter, claim 18, lines 16-21, has been amended to read as follows:

*electronically sensing amounts of coins dispensed from the machine for the respective users and electronically sensing amounts of coins loaded into the machine by said respective users; and*

*storing said electronically sensed amounts of coins in a memory in the machine in association with respective users without manually re-entering said electronically sensed amount of coins into the machine.*

Claim 26, lines 7-16 recites:

*electronically sensing at the dispensing hoppers the amount of coinage dispensed in the first operating cycle and storing the amount of dispensed coinage in memory in the machine in association with a user account number, which is one of the inputs from the user;*

*responding to inputs from a user and a batch of coins put into the machine from the user coin receptacle in a second operating*

*cycle of the machine to total the coinage put into the machine, to store the total in memory in the machine in association with a user account number, and to store the coinage in bulk coin storage receptacles by denomination;*

Support for these recitations in claims 18 and 26, is provided by at least the following passages.

[Support: Para. 0044: "The main processor board 84 is directly connected to sensors 88 (FIG. 11) at the sorting exits of the sorter 21 to sense and count denominations sorted by the sorter 21." Para. 0045: "So, too, the dispensing hopper count sensor 90 for detecting and counting coins as they exit each hopper 46-49 would be connected through the I/O interface board to send count signals or at least count totals back to the main controller CPU." Para. 0051: The next block 102 represents storage for an amount of coin received from a particular employee. The next block 103 represents storage for an amount of coinage input by a specific employee. The next block 104 represents a report of all transactions for each employee for each work shift.

Para. 0057: When all of the hoppers have completed operation, the amounts dispensed are available to be sent to the personal computer 97 from the controller 80, as represented by process block 134. Para. 0059: "The sorter 21 then sorts the coins and stores coins of respective denominations in the respective BCS receptacles 31-34." "The amount deposited is counted by sensors 88 on the coin sorter 21 as the coins are sorted. . . . The deposited amounts are stored in the controller memory along with the user account number."]

Claim 23 has been amended to recite:

*"storing a plurality of user accounts in memory with a balance per user of cash received and cash dispensed during a work shift."*

It is now clear when considering the limitations of claim 18, from which claim 23 depends, that the totals and cash balances per user per work shift, are automatically stored in the same machine as the machine doing the cash handling. None of the references teach this, including Carter and Jones et al. '537.

Claim 24 and claim 28 have been amended to recite:

*"associating said identification inputs from a plurality of users with amounts of coins stored in memory and corresponding to amounts of coins dispensed and received for respective users during their respective work shifts."*

It is now clear that when considering the limitations of claim 18, from which claim 24, that the totals and amounts of coins dispensed and received are automatically automatically stored in the same machine as the machine doing the cash handling. None of the references teach this, including Carter and Jones et al. '537.

At page 5, lines 16-19, the Examiner states that:

At the time of the invention, it would have been obvious to one of ordinary skill in the art to have added Carter's balancing program with Jones' coin recycling and processing device for the purpose of handling Jones' cash tills in a retail environment. See Carter, paragraphs 4-9.

The citation of paragraph 0004-0009 of Carter is not consistent with the actual disclosure in Carter, particularly paragraphs 0022-0072 or the claims of Carter as issued. Carter does not suggest that its computer program would be installed in a machine such as Jones et al. '537. Jones et al. '537 makes no suggestion of adding the type of program as disclosed in Carter.

Jones et al. '537 is content with the disclosure at col. 18, lines 59-65, as follows:

The coin processing module 250 initially counts the coins to determine the aggregate value of the coins deposited by an individual user for purposes of that particular transaction. Further, the coin processing module 250 can keep track of the coin totals (value, number of coins, etc.) over a given time interval for quality control purposes.

As further discussed at col. 13, lines 39-64, dispensed amounts in Jones et al. '537 are identified by destination gaming machine not by an employee receiving the amounts. The user putting in an ID number is for access to the machine, so the Examiner's reference to the employee putting in the ID number without more information is not anticipating the limitations of the claims.

Jones et al. '537 has no suggestion of recycling in the sense of the present invention, and Carter has no method to automate the coin handling of batches received and dispensed from its loose inventory.

The present invention of claim 18, lines 2-5, provides for:

*dispensing coins by denomination from a plurality of dispensing hoppers in a machine to a user coin receptacle having*

*compartments for receiving respective denominations and totaling amounts dispensed in relation to respective users;*

The Office Action states at page 3, last paragraph that:

“Further regarding Claims 18, 23, 24 and 26, Jones discloses dispensing coins by denomination from a plurality of dispensing hoppers (402a-402f) as illustrated at figure 21, in a machine to a user coin receptacle (Geib's till (250)) having compartments for receiving respective denominations and totaling amounts dispensed in relation to respective users. Note that Jones discloses user identification at col. 5, lines 25-38;”

To make this finding, these two references are combined without a meaningful motivation or suggestion and without a known and documented engineering method or reason for doing so under the principles of *KSR Int'l Co. v. Teleflex, Inc.*, 550 U.S. 398, 82 U.S.P.Q.2d 1385 (2007).

Jones, Fig. 21 is disclosed as dispensing to the receptacles 251 in Fig. 13a-13c of Jones et al. and not to a coin receptacle having multiple compartments. (Jones et al. '537, col. 20, line 7.)

Jones et al., U.S. Pat. No. 6,637,576 is made of record in the accompanying Information Disclosure Statement. The next machine in Jones evolution is shown in Figs. 24 and 25. That machine dispenses through fixed tubes 541-546 to coin bags 606, not to a drawer or till.

The Geib et al. till is not disclosed as being useable in Jones et al. '537 machine due the need for the routing modules disclosed in Figs 5-7

in Geib et al., U.S. Patent Pub. No. 2001/0034203 and Fig. 11 in Geib et al. U.S. Pat. No. 5,997,395. Such routing modules for dispensing to a cash drawer are not present in, or useable in, Jones et al. '537.

Geib et al., U.S. Pat. No. 5,997,395 is not seen to be any more relevant than Geib et al., U.S. Patent Pub. No. 2001/0034203 cited at para. 0003 of the specification in the present application and submitted with Information Disclosure Statement herein

Geib et al., U.S. Patent Application No. 2001/0034203, Fig. 1 shows Geib et al. U.S. Pat. No. 5,997,395 as prior art and discusses this at paragraph 0021, first three lines. These patent documents are directed to a fixed chute system (Figs 5-7 in Geib et al., U.S. Patent Pub. No. 2001/0034203 and Fig. 11 in Geib et al. U.S. Pat. No. 5,997,395) for directing coins from a sorter to a cash drawer, but both of these Geib et al. references lack the bulk coin storage receptacles and the dispensing hoppers of claims 18 and 26. Furthermore, both of these Geib et al. references lack the directing, transferring and dispensing operations to and from these coin holding elements as recited in claim 18, lines 10-11, 12-15 and 2-4, and claim 26, lines 12-16, 21-25 and 3-6.

Thus, the combination of Geib's till with the machines of Jones et al. '537 made at page 3, last paragraph, of the Office action is unsupported by any reasonable engineering evidence. In addition, many of the limitations recited in claims 18 and 26, such as the combined actions of receiving and dispensing to a till and recording amounts by user in memory the machine are not satisfied, so a case of *prima facie* obviousness is not established by the present combined teachings of these two references. The knowledge of one of ordinary skill in the art is



not enough to supply missing claim limitations to establish a *prima facie* case of obviousness unless the knowledge is contained in a source that can be reviewed.

MPEP 2144.03 sets forth the procedure for relying on common knowledge and states in part:

It would not be appropriate for the examiner to take official notice of facts without citing a prior art reference where the facts asserted to be well known are not capable of instant and unquestionable demonstration as being well-known. For example, assertions of technical facts in the areas of esoteric technology or specific knowledge of the prior art must always be supported by citation to some reference work recognized as standard in the pertinent art. *In re Ahlert*, 424 F.2d at 1091, 165 USPQ at 420-21. See also *In re Grose*, 592 F.2d 1161, 1167-68, 201 USPQ 57, 63 (CCPA 1979) ("[W]hen the PTO seeks to rely upon a chemical theory, in establishing a prima facie case of obviousness, it must provide evidentiary support for the existence and meaning of that theory."); *In re Eynde*, 480 F.2d 1364, 1370, 178 USPQ 470, 474 (CCPA 1973) ("[W]e reject the notion that judicial or administrative notice may be taken of the state of the art. The facts constituting the state of the art are normally subject to the possibility of rational disagreement among reasonable men and are not amenable to the taking of such notice.").

MPEP 2143.01 Subsection (G) set forth that citation of well known prior art is for the purpose of showing teaching, suggestion or motivation (TSM) to combine and not to supply elements of the claims needed to establish a *prima facie* case of obviousness.

Claim 18, lines 10-13, further distinguishes Jones et al. '537 and the other prior art, by reciting:

*"electronically controlling a plurality of mechanisms that transfer coins from said bulk coin storage receptacles by denomination to*

*corresponding ones of said dispensing hoppers for dispensing to a respective user;*

The transfer occurs as coins move from the input receptacles (the bulk coin storage receptacles) to the output receptacles (the dispensing hoppers.) The Examiner has not shown where this subject matter is found in Jones et al. '537.

The Examiner states further at page 3, in the fourth paragraph:

“Jones further discloses electronically controlling (39) a plurality of mechanisms that transfer coins from said bulk coin storage receptacles by denomination to corresponding ones of said dispensing hoppers (36) for dispensing to a respective user.”

This is respectfully believed to be in error. The Office actions have not documented that both bulk storage coin receptacles and dispensing hoppers in any one embodiment in Jones et al. '537. The suggestion that the bulk storage receptacles are elements 40 in Fig. 2 and that the dispensing hoppers are elements 36 is also in error. In Jones et al. '537, col. 8, line 60- col. 9, line 2, a coin cartridge 56 (Fig. 5) is used to collect coins of one denomination of coins at station 40 and the cartridge is moved (manually) to coin dispensing station 36. At col. 9, lines 17-26 a conveyor (not pictured) is said to replace one of the coin receptacles 50 to receive and move coins to the dispensing station 36, rather than to take coins out of receptacles 50 to transport them to coin dispensing station 36.

First, this conveyor embodiment is incomplete and not illustrated in Jones.

Second, the coin receptacles 50 are analogous to the cash till, they are end receiving receptacles and are not intermediate receptacles.

The Jones et al. '537 patent provides only one set of intermediate receptacles 402a-402f. Most of the embodiments have no intermediate receptacles other than the final coin receptacles 50 themselves. If the Examiner reads the receptacles 402 as dispensing hoppers, they cannot be the bulk coin storage receptacles which are recited in claim 18 and 26. .

There are no "two types of receptacles" operating in series in Jones et al.

It has been clear that Jones et al. '537 shows no (0) tiers of hoppers in Figs. 1-10 and 13a-13c and only one (1) tier of hoppers in Figs. 20-22 for both receiving and dispensing coins, whereas the present invention claims two tiers of hoppers/receptacles with coins transferred between them prior to dispensing

In addition, Jones et al. Fig. 20 remixes the denominations or dispenses only one denomination at time through a common user convey path 410 and a common operator convey path 412.

Applicants are aware of the prior citation of Harris for this subject. In the new ground of rejection, Harris is discussed at page 4, paragraph second paragraph of the Office Action as follows:

Regarding Claims 18 and 26, Jones does not expressly disclose, but Harris discloses using a bulk coin receptacle, (70), to fill a dispensing hopper (56) when a low condition is sensed in the

primary hopper, for the purpose of increasing the capacity of the machine, thereby reducing the need to replenish the machine and the cost of labor as well as reducing machine downtime. See Harris at col. 1, line 61-col. 2, line 35, which describes the problem of dispensing hopper depletion which causes machine downtime. Note also that Harris discloses at col. 3, lines 10-33 that a set of sensors detect the levels of both the bulk coin receptacle and the dispensing hopper.

It would not be obvious to incorporate a suitable controller for handling multiple denominations and five of Harris' units in a gravity-type machine, not much bigger than Harris' machine (slot machine size) and provide such a combined machine with the capability of executing the following steps 1) loading batches of coins having a plurality of denominations into a machine; 2) dispensing coins from a from a plurality of dispensing hoppers in the machine; and 3) transferring coins from said bulk coin storage receptacles by denomination to corresponding ones of said dispensing hoppers. (Harris is a one-denomination slot machine) and 4) storing the amounts received and dispensed for respective employees (claims 18 and 26) over a work shift (claims 23, 24 and 26).

In addition, it is not obvious to combine Harris with Jones et al. '537 because Jones et al. '537, is a gravity feed machine and Harris uses a lifting mechanism in opposition to gravity to transfer coins from a single receptacle to a single dispensing hopper.

The first Office action in this application was issued on January 25, 2007, and there was a restriction requirement based on two Species.

The Examiner stated on page 2, second and paragraphs that:

"Species I, directed to Figs. 6-9, concerns a coin hopper with (a) lifting device to lift the coins to the top of the hopper, wherein they are skimmed off the top into a another receptacle."

"Species II, directed to Fig. 10, concerns a coin hopper with a gravity feed of coins from the bottom to another receptacle."

"The species are independent or distinct because a gravity fed hopper operates differently than a coin hopper with a lifting device that lifts the coins to then be skimmed off the top of the hopper into another receptacle.

All of the illustrated embodiments in Jones et al. '537 are drawn to gravity-fed machines. It would be nonobvious to combine the mechanisms of Jones et al. '537 and Harris because as the Examiner said at a time when the issue was neutral that "The species are independent or distinct because a gravity fed hopper operates differently than a coin hopper with a lifting device that lifts the coins to then be skimmed off the top of the hopper into another receptacle.

It is well settled law that if the proposed modification or combination of the prior art would change the principle of operation of the prior art invention being modified, then the teachings of the references are not sufficient to render the claims *prima facie* obvious. *In re Ratti*, 270 F.2d 810, 123 USPQ 349 (CCPA 1959).

II. RECONSIDERATION AND ALLOWANCE OF SPECIES CLAIMS 21 AND 22 IS REQEUSTED.

Claim 21 herein specifically recites the lifting operation as follows:

*"transferring coins from the bulk coins storage receptacles by lifting coins from the receptacles to a predefined height and rotationally skimming the coins into the dispensing hopper."*

Thus, while this step was known for a single receptacle in Harris, the Examiner has not shown why Jones et al. '537 which shows three gravity-feed machines would depart from this gravity-feed principle.

In this respect, Jones et al. '537 does not even suggest the gravity feed solution in withdrawn and amended claim 22 of:

*feeding the coins from bulk coin storage receptacles to the dispensing hoppers by gravity, and transferring coins from the bulk coin storage receptacles to the dispensing hoppers by gravity feeding downward from the bulk coin storage receptacles to the dispensing hoppers.*

This claim has been amended to render it in method form as opposed to the apparatus form of claim 10, in the event the Examiner would allow the method claims and allow rejoinder of this claim.

### III. REJOINDER OF CLAIMS 10 AND 22 IS REQUESTED

Claims 1-9 and 11-17 have been allowed. Therefore, rejoinder of claim 10, which is a second species, is respectfully requested under MPEP 821.04, as being directed to a reasonable number of species dependent on a generic claim 1, which has been allowed.

Rejoinder of claim 22 is also respectfully requested under MPEP 821.04, conditional upon an indication of allowance of generic claim 18, as being directed to a reasonable number of species dependent on claim 18, which is generic.

### CONCLUSION

In view of the Amendment and Remarks, reconsideration of the application is respectfully requested. After the Amendment, claims 1-9, and 11-17 have been allowed. Claims 18-21 and 23-29 are still pending. Rejoinder and allowance are requested for claim 10 as being dependent on allowed claim 1. Rejoinder for claim 22 is requested, conditional upon allowance of the claim 18 from which claim 22 depends, and a Notice of Allowance for claims 1-29 is earnestly solicited.

Respectfully submitted,

By:



Michael J. McGovern  
Reg. No. 28,326  
Boyle Fredrickson S.C.  
840 N. Plankinton Ave.  
Milwaukee, WI 53203  
(414) 225-6713